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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,336	09/25/2007	Konrad Kemper	2400.0740000/VLC/DAS	2752

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.  
1100 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
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BROWN, COURTNEY A

ART UNIT	PAPER NUMBER
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1616

MAIL DATE	DELIVERY MODE
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10/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/598,336	<b>Applicant(s)</b> KEMPER ET AL.	
	<b>Examiner</b> COURTNEY BROWN	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/2/2007</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

Claims 1-10 are pending and are being examined for patentability.

### ***Priority***

Priority to EPO Application 04014307.5 filed on June 18, 2004 is acknowledged.

### ***Information Disclosure Statement***

The Information Disclosure Statements (IDS) submitted on June 25, 2008 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suarez-Cervieri et al. (US Patent Application 20050032903) in view of Asrar et al. (US Patent 7,098,170 B2).

***Applicant's Invention***

Applicant claims a method of protecting soya beans against soya bean rust comprising applying one or more demethylation inhibitor (DMI) fungicides selected from the group consisting of:

a) triazoles: a.1. azaconazole, a.2. bitertanol, a.3. bromuconazole, a.4. cyproconazole, a.5. difenoconazole, a.6. diniconazole, a.7. epoxiconazole, a.8. fenbuconazole, a.9. fluquinconazole, a.10. flusilazole, a. 11. flutriafol, a.12. hexaconazole, a.13. imibenconazole, a.14. ipconazole, a.15. metconazole, a. 16. myclobutanil, a. 17. paclobutrazol, a. 18. penconazole, a. 19. propiconazole, a.20. prothioconazole, a.21. simeconazole, a.22. tebuconazole, a.23. tetraconazole, a.24. triadimenol, a.25. triticonazole;

b) pyrimidines: b. 1. fenarimol, b.2. nuarimol;

c) pyridines: c. 1. pyrifenox; and

d) imidazoles: d.1. imazalil, d.2. oxpoconazole fumarate, d.3. peforazoate, d.4. prochloraz, d.5. triflumizole; ; and mixtures thereof as seed dressing for to said soya beans.

***Determination of the scope and the content of the prior art  
(MPEP 2141.01)***

Suarez-Cervieri et al. teach a method for controlling rusts in legumes, which comprises treating the aerial plant part of the legumes with an aqueous preparation of a

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strobilurin-containing formulation (abstract). Suarez-Cervieri et al. teach that severe incidence of rust diseases in soybean crops is caused by the harmful fungi *Phakopsora pachyrhizi* and *Phakopsora meibomia* ([0002]). Suarez-Cervieri et al. teach the use of azols such as bitertanol, bromoconazole, cyproconazole, difenoconazole, dinitroconazole, epoxiconazole, fenbuconazole, fluquiconazole, flusilazole, hexaconazole, imazalil, metconazole, myclobutanil, penconazole, propiconazole, prochloraz, prothioconazole, tebuconazole, triadimefon, triadimenole, triflumizole, triticonazole ([0029]) as possible fungicides, combined with a strobilurin-type fungicides that can be used to treat rust. Suarez-Cervieri et al. also teach the treatment of seed ([0044]).

***Ascertainment of the difference between the prior art and the claims  
(MPEP 2141.02)***

The difference between the invention of the instant application and that of Suarez-Cervieri et al. is that the instant invention requires the use of one or more fungicides selected from the group consisting of triazoles, pyridines, pyrimidines, and imidazoles as opposed to strobilurin –type fungicides. For this reason, the teaching of Asrar et al. is joined. Asrar et al. teach a method of improving the yield and vigor of an agronomic plant which involves treating plants such as soybeans and corn and/or their propagation material with a composition that includes an active agent, such as a diazole fungicide, a triazole fungicide, or a strobilurin-type fungicide, which has the capacity

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to improve the yield and/or the vigor of the plant in the absence of pest pressure by fungal plant pathogens (abstract).

***Finding of prima facie obviousness***

***Rationale and Motivation (MPEP 2142-2143)***

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of the two cited references to arrive at a method of protecting soya beans against soya bean rust. Suarez-Cervieri et al. teaches that the use of a triazole compound such as prothioconazole is effective at protecting soybean from harmful fungi such as *Phakopsora pachyrhizi* and *Phakopsora meibomiaae*. Asrar et al. teach the application of triazole fungicides or strobilurin-type fungicides are effective for treating seed of soy beans against fungal plant pathogens. One would have been motivated to make this combination in order to receive the expected benefit of having a method that is effective against protecting soybeans from soybean rust using only one active agent. "It would be prima facie obvious to combine two methods each of which is taught by the prior art to be useful for the same purpose in order to form a resultant method that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art." In re Kerkhoven, 205 USPQ 1069 (C.C.P.A. 1980).

***Conclusion***

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None of the claims are allowed.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR Only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Courtney Brown, whose telephone number is 571-270-3284. The examiner can normally be reached on Monday-Friday from 8 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Courtney A. Brown  
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/Johann R. Richter/  
Supervisory Patent Examiner, Art Unit 1616